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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,192	12/12/2000	Kazuhiko Tomita	1344.1051/JDH	4249
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EXAMINER WINTER, JOHN M				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/734,192

Applicant(s)

TOMITA, KAZUHIKO

Examiner

JOHN M. WINTER

Art Unit

3685

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 17-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13, 17-19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. The Applicants amendment filed on September 3, 2009 is hereby acknowledged, Claims 13, 17-19 and 21 remain pending.

Response to Arguments

2. The Applicant's arguments filed on September 3, 2009 have been fully considered.

The Applicant states that Claim 13 is directed to electronically authorizing or repudiating an electronically processed task. As the review process is implemented "electronically" where "an electronic authorization or repudiation of said tasks" is executed, the method is apparently tied to a machine, which is within the statutory subject matter.

The Examiner responds that the mere usage of an electronic authorization fails positively recite the machine that accomplishes the method steps.

The Applicant states that the prior art references do not teach or suggest "among said elements forming the current task to be electronically authorized, an element matching at least one of said elements of the previously reviewed tasks is designated as a check point for review when a number of repudiation reasons in comparison to a number of authorizations of said elements for the reviewed tasks and the user meet a predetermined condition ", as recited in claim 13 for example.

The Examiner responds that the claimed feature is directed towards a conditional claim limitation (e.g. when a number of repudiation reasons in comparison to a number of authorizations of said elements for the reviewed tasks and the user meet a predetermined

condition) and therefore does not have patentable merit -- See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 13, 17-19 and 21 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent

(See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

4. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.
5. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.
6. In this particular case, claim 13 fails prong (1) because the “tie” (e.g. electronic authorization) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.
7. Claims 17-19 and 21 contain similar limitation as claim 13 and are rejected for at least the same reasons.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 13, 17-19 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 and 17-19 contains the limitation “previously reviewed tasks” without the step of initially reviewing the tasks. Claim 13 contains the limitation “a user identifier requesting authorization”, it is unclear how an “identifier” could request information.

Claims 13 and 21 contains the term “and/or” which is indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 13, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nummelin et al (US Patent 6,308,164) in view of Abbruzzese et al., (US Patent No 5,557,515) and further in view of Underwood (US Patent 6,718,535).
10. As per claims 13, 17- 19 and 21

Nummelin et al ('164) discloses a method of electronically authorizing or repudiating an electronically processed task, comprising:

storing a plurality of elements forming tasks subsequent to reviews indicating an electronic authorization or repudiation of said tasks, each of said plurality of elements including a user identifier requesting authorization and/or repudiation reasons and a date of authorization and/or repudiation; (Column 7, lines 24-37 [validating information input into specific fields.... Input or update project data])

retrieving repudiation reasons of elements of previously reviewed tasks among said elements stored that match elements forming a current task to be electronically authorized and a user requesting authorization of said current task, said current task being separate from the previously reviewed tasks; (Column 6, lines 37-49 [retrieves status reports for designated operators of equipment i.e. authorizer of the task; it is obvious that the task status would be derived from the elements stored in a database., also generally disclosed by Figure 2,3; Figure 2 discloses task elements in database, Figure 3 discloses verification/authorization process.])

11. Nummelin et al ('164) does not explicitly disclose “displaying said retrieved repudiation reasons of said elements of said previously reviewed tasks and retrieved repudiation reasons for the user in association with said elements of the current task to be electronically authorized” Abbruzzese et al ('515) discloses “displaying said retrieved repudiation reasons of said elements of said previously reviewed tasks and retrieved repudiation reasons for the user in association with said elements of the current task to be electronically authorized. (Figure 9A, column 64, lines 56-67, column 65, lines 1-67 [the

diary function shows alerts for items that need processing, table LVII has a field for “reason” i.e. repudiation reason.]) in association with said elements of the task to be electronically authorized “. (Column 65 – lines 29-67) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Nummelin et al (*164) method with the Abbruzzese et al (*515) method in order to detect when a case needs additional managerial attention.

Nummelin et al (*164) does not explicitly disclose “wherein among said elements forming the current task to be electronically authorized, an element matching at least one of said elements of the previously reviewed tasks is designated as a check point for review when a number of said retrieved repudiation reasons of the elements in comparison to a number of authorizations of said elements for the reviewed tasks and the user meet a predetermined condition, and an accumulated number of repudiation reasons totaling a number for each repudiation reason within a designated term is displayed as the check point” Underwood (*535) discloses “wherein among said elements forming the current task to be electronically authorized, an element matching at least one of said elements of the previously reviewed tasks is designated as a check point for review when a number of said retrieved repudiation reasons of the elements in comparison to a number of authorizations of said elements for the reviewed tasks and the user meet a predetermined condition, and an accumulated number of repudiation reasons totaling a number for each repudiation reason within a designated term is displayed as the check point “. (Column 209lines 8-25 also discussion of “window fields starting at column 209, line 10, the Prior CR# field references previous “repudiation reasons”) It would be

obvious to one having ordinary skill in the art at the time the invention was made to combine the Nummelin et al ('164) method with the Underwood ('535) method in order to create a controlled environment for project development.

With respect to claim 17 the Examiner notes that the feature of "where said element identified" is directed towards non-functional descriptive material and it has been held such information will not distinguish a claimed device from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01)

With respect to claim 1, 18 and 21 Examiner notes the language such as "wherein" and "when" are conditional elements and fail to limit the claimed invention.

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/
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